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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/982,284 12/01/97 LUBON

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HM12/0605

EXAMINER

HAUDA, K

ART UNIT

PAPER NUMBER

1632

DATE MAILED:

06/05/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/982,284

Applicant(s)  
Lubon et al.

Examiner  
Karen M. Hauda

Group Art Unit  
1632



☒ Responsive to communication(s) filed on Feb 29, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 5-7, 11-13, 15, 45-47, 51-57, and 61-65 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 5-7, 11-13, 15, 45-47, 51-57, and 61-65 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 16

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

Applicant's amendment was filed February 29, 2000. Claims 1, 8, 16-44, 48-50, 58-60 and 66 were canceled. Claims 5-7, 11-13, 15, 45-47, 51-57, and 61-65 are pending.

#### ***PTO-1449 Consideration***

The Examiner has considered the translated abstract of FR 2 717 500 and Velandar, W., July, 1997 as requested by applicants.

#### ***Sequence Compliance***

The prior objection to the specification with respect to sequence compliance is withdrawn in view of applicants submission of an effective sequence listing.

#### ***Claim Objections***

Claim 63, as amended, is objected to as depending from claim 56 and 72 without indicating that these are in the alternative.

#### ***Claim Rejections - 35 USC § 112***

Claims 5-7, 11-13, 15, 45-47, 51-57, and 61-65 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate with the scope of the claimed invention.

While the specification is enabled for a **non-human transgenic mammal** whose genome comprises an nucleic acid sequence comprising a whey acidic promoter (WAP) operably linked to a gene encoding a modified stromelysin-1 gene as taught by the prior art, wherein expression of

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said stromelysin-1 gene by somatic cells in said transgenic mammal results in the production of said protein in the urine of said transgenic mammal; and methods of producing the same or other transgenic mice known in the art to secrete a protein which detoxifies or degrades organic material in the urine. The specification does not reasonably provide enablement for the breadth of the claimed invention. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicants argue that there is no undue experimentation to produce transgenic animals of any and all species given that the specification supports that Protein C was produced in both transgenic mice and pigs. However, as discussed in the previous office action, the examples provided in Figure 5 and Table III are limited to the production of transgenic mammals using the WAP promoter. The prior art has demonstrated that mammary specific regulatory regions can reproducibly direct a protein of interest to the milk, blood, or urine of a representative number of transgenic **mammals** (see USPN 5,880,327, for example). However, this is the exception to the unpredictable transgenic art and has not been found to be the norm as is supported by the teachings of Strojek and Wagner, Houdebine, Wall and Kappel as set forth in the previous office action. In fact, some of applicants claims encompass the production of transgenic dogs, cats, and horses, but to date none of these mammals have been transgenically produced using any transgene construct. Furthermore, the methods of producing transgenic birds and reptiles differs dramatically from that of transgenic mammals and there is no evidence that mammalian promoters

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would function in these species or that correlative regulatory sequences even exist or could be identified in these species.

It is further noted that applicants have limited their claims to proteins with degrade or detoxify organic material, however, there is no evidence within the specification or the prior art that protein C can detoxify or degrade organic material. Organic material encompasses connective tissues and organs which are essential to the generation of a transgenic animal, however, applicants specification fails to teach how toxic proteins and peptides can be altered to generate transgenic animals without degrading the tissues of the animal. D'Armiento et al. teach the production of a matrix metalloproteinase (MMP) collagenase transgenic mouse to study the expression of the human collagenase in the epithelium of the tissue (page 5734, column 2, line 6; also see the abstract). These mice die shortly after birth. MMP's are a class of extracellular matrix degrading enzymes which are clearly encompassed within the phrase "degrades or detoxifies organic material." Therefore, it is evident that the expression of proteins that degrade or detoxify organic material may have an effect on the growing organs or tissues such that survival of the animal is unpredictable. Applicant's claims are directed to any and all proteins or peptides which degrade or detoxify organic material, yet the specification fails to teach one of skill in the art how to identify appropriate proteins or peptides which can be used to generate transgenic animals such that the animals survive and produce the protein in the urine to measurable amounts. In fact, the specification fails to provide a working example for a single transgenic animal expressing a protein or peptide which degrades or detoxifies organic material,

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yet the claimed are directed to all transgenic animals expressing any or all proteins or peptides which degrade or detoxify organic material.

Applicant's argue that prior to the effective filing date many researchers were producing many different proteins in a "broad range of hosts." The Examiner does not contradict this.

However, the prior art clearly teaches that the particular transgene construct is imperative to the ability to produce a transgenic animal with a predictable phenotype. The level and the specificity of expression of a transgene as well as the phenotype of the transgenic animal thus produced are greatly dependent of the **specific** transgene construct used. The individual gene of interest, promoter, enhancer, coding or non-coding sequences present in the transgene construct, the site of integration, etc., are all important factors in controlling the expression of a transgene.

Applicant's specification in conjunction with the prior art only supports the production of proteins in the urine with transgene constructs utilizing the WAP promoter for mammals and the uroplakin II promoter in mice operably linked to a protein which **does not** degrade or detoxify organic material. The specification fails to teach one of skill in the art how to utilize these promoters with genes known in the art to degrade or detoxify organic material such that a transgenic mouse or pig could be produced and survive to produce a protein which degrades or detoxifies organic material in the urine of the mammal. While the prior art does teach expression of a modified stromelysin-1 enzyme under control of the WAP promoter (see Simpson et al. below), the specification fails to teach how to modify the numerously claimed enzymes listed in Figure 7, or other enzymes encompassed by the claims, such that viable transgenic animals can be produced.

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Therefore, the claimed invention is enabling only for a **non-human transgenic mammal** whose genome comprises a nucleic acid sequence comprising a whey acidic promoter (WAP) operably linked to a gene encoding a modified stromelysin-1 gene as taught by the prior art, wherein expression of said stromelysin-1 gene by somatic cells in said transgenic mammal results in the production of said protein in the urine of said transgenic mammal; and methods of producing the same or other transgenic mice known in the art to secrete a protein which detoxifies or degrades organic material in the urine.

Therefore, for the reasons set forth above and in the previous office action, the rejection is maintained.

The prior rejection of claims 52, 53, 62, and 63 under 35 USC § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is withdrawn.

The prior rejection of claims 1, 5-8, 11-13, 15 and 45-65 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn.

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***Claim Rejections - 35 USC § 102***

The prior rejection of claims 45-49, 51, 52, 54-59, 61, 62, 64 and 65 under 35 U.S.C. 102(b) as being anticipated by Sun et al (USPN 5,824,543). or Sun et al.(WO 96/39494) is withdrawn.

The prior rejection of claims 45-49, 51, 52, 54-59, 61, 62, 64 and 65 under 35 U.S.C. 102(b) as being anticipated by Lubon et al. is withdrawn.

Claims 56-57, 61, 64 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Sympson et al.

Sympson et al. taught the production of a transgenic mouse expressing a rat stromelysin-1 cDNA under control of the WAP promoter. The WAP promoter directs expression inherently into the urine (see page 28 of the specification or USPN 5,880,327, column 6). Therefore, Sympson et al. anticipates the claimed invention.

***Claim Rejections - 35 USC § 103***

The prior rejection of claims 1, 5-8, 11-13, 15, 45-52, 54-62, 64 and 65 under 35 U.S.C. 103(a) as being unpatentable over Sun et al.(USPN 5,824,543). or Sun et al.(WO 96/39494) in view of Lubon et al. is withdrawn.



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Claims 45-47, 51, 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of Wen et al. (PTO-1449, A41) and Lubon et al. (USPN 5,880,327).

Simpson et al. taught the production of a transgenic mouse expressing a rat stromelysin-1 cDNA under control of the WAP promoter. The WAP promoter directs expression inherently into the urine (see page 28 of the specification or USPN 5,880,327, column 6). Simpson et al. does not suggest that the stromelysin-1 gene could be isolated from the urine. However, at the time the claimed invention was made, Wen et al. and Lubon et al. taught that proteins of interest could be isolated from other tissues, such as the urine, using the WAP promoter. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to collect and isolate stromelysin-1 protein from the urine of the transgenic mice produced by Simpson et al. with a reasonable expectation of success. Therefore, the claimed invention was *prima facie* obvious in the absence of evidence to the contrary.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen M. Hauda whose telephone number is (703) 305-6608.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, may be reached at (703) 308-2035.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2801.

**To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1632.**

Papers related to this application may be submitted to Group 160 by facsimile transmission. Papers should be faxed to Group 160 via the PTO Fax Center located in Crystal

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Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is or (703) 305-3014 or (703) 308-4242.

*Karen M. Hauda*  
**Karen M. Hauda**  
**Patent Examiner**